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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/052,608	01/18/2002	Lee Macklin	10011295-1	2966

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EXAMINER

DIETRICH, ETHAN M

ART UNIT PAPER NUMBER

3692

DATE MAILED: 11/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/052,608

Applicant(s)

MACKLIN ET AL.

Examiner

Ethan M. Dietrich

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-3, 8 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by McGurl et al, U.S. Patent No. 5,893,080.

Claim 1: McGurl discloses a “network based payment processing system comprising:

an input process configured to receive disbursement requests (Col. 2 lines 49-52),

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an authorization process configured to apply predetermined rules to control verifying proper authorization of said disbursement requests (Col. 4 18-23, Col. 6 lines 6-13; Col. 6 lines 28-32),

an accounting process configured to track parameters pertaining to the fulfillment of authorized ones of said disbursement requests (Col. 5 lines 36-41, Col. 6 lines 28-32, Col. 6 lines 39-41), and

an output process configured to process said disbursement requests for payment (Col. 5 lines 13-36)."

Claim 2: McGurl discloses a "network based payment processing system of claim 1 wherein said input process includes a communications interface to an intranet (Col. 3 lines 27-38)."

Claim 3: McGurl discloses a "network based payment processing system of claim 1 wherein said input process includes a graphical user interface (Col. 3 lines 55-59)."

Claim 8: McGurl discloses a "network based payment processing system of claim 1 wherein said output process is further configured to initiate an electronic fund transfer to effect said payment to a recipient (Fig. 1 item 34; Col. 4 lines 54-59)."

Claim 9: McGurl discloses a "network based payment processing system of claim 1 wherein said output process is further configured to generate a negotiable instrument in a tangible form to effect said payment to a recipient (Fig. 1 item 36; Col. 4 lines 54-59)."

Claims 10-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Kahn et al, U.S. Patent No. 6,401,079.

Claim 10: Kahn discloses a "network based method of disbursing funds, said network based method including the steps of:

receiving a disbursement request (Fig. 3 item 1110; Col. 18 lines 30-32);

applying predetermined rules to authorize said disbursement request (Abstract; Col. 15 lines 20-31);

supvising [sic] the proper approval based on applied ones of said authorization rules (Abstract; Col. 5 lines 25-35);

tracking available funds from which said disbursement is to be drawn (Col. 6 lines 8-23); and

processing said disbursement for payment (Col. 5-6)."

Claim 11: Kahn discloses a "method of claim 10 wherein said disbursement receiving step includes the step of receiving said request over an intranet (Fig. 1 item 15)."

Claim 12: Kahn discloses a "method of claim 10 further including the step of presenting a graphical user interface to said requesting party (Figs. 5-46b)."

Claim 13: Kahn disclose a "method of claim 10 wherein one of said predetermined rules denies authorization of said request when a requesting party is identical to a receiving party (Col. 48 lines 9-14; Col. 5 lines 47-51)."

Claim 14: Kahn discloses a "method of claim 10 wherein one of said predetermined rules denies authorization of said request when said request exceeds a maximum authorization amount (Col. 14 lines 56-59)."

Claim 15: Kahn discloses a "method of claim 10 wherein one of said predetermined rules denies authorization of said request when said request is not complete (Col. 17 lines 64-67, Col. 18 lines 1-10; Col. 40 lines 29-36)."

Claim 16: Kahn discloses a "method of claim 10 wherein said step of tracking includes the step of tracking a plurality of disbursement categories (Col. 24 lines 54-63)."

Claim 17: Kahn discloses a "method of claim 10 further including the step of transferring a payment via electronic fund transfer (Fig. 3 item 1160)."

Claim 18: Kahn discloses a "method of claim 10 further including the step of generating a negotiable instrument in a tangible form to effect said payment to a recipient (Fig. 3 item 1150)."

Claim 19: Kahn discloses a "payment system comprising:
a web server configured to host a payment processing site for receiving payment requests (Fig. 3 item 1100, Fig. 1 item 15; Col. 18 lines 17-32);
an authorization module configured to control proper authorization of said payment requests to provide approved payments (Col. 54 lines 54-56, Col. 55 lines 1-46, Col. 56 lines 46-50);

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an accounting module configured to verify fund availability and to track fund disbursement in connection with said approved payments (Col. 50 lines 8-29; Fig. 43; Col. 51 lines 64-67, Col. 52 lines 1-34); and

a payment module configured to initiate payment to recipients designated in connection with said approved payments in response to said verification of fund availability and said proper authorization (Fig. 3 item 1140)."

Claim 20: Kahn claims a "payment system of claim 19 wherein said authorization module includes a routing module configured to obtain authorization of said payment from a number of authorization entities (Col. 54 lines 54-56, Col. 55 lines 1-46, Col. 56 lines 46-50)."

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over McGurl as applied to claim 1 above, and further in view of Kahn et al, U.S. Patent No. 6,032,133. McGurl does not specifically disclose a "network based payment processing system of claim 1 wherein said predetermined rules include a rule denying authorization when a disbursement request has a requesting party that is not different from a designated recipient specified in said disbursement request." However, Kahn discloses such a system (Col 5 lines 47-51, Col. 48 lines 9-14). It would have been obvious to one skilled in the art to combine these references because doing so gives the employer greater control over the payroll approval process, possibly preventing theft by employees. Kahn offers the motivation to combine, stating that the system creates security that allows the employer greater control the approval of payments to employees (Col. 48 lines 9-14).

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over McGurl as applied to claim 1 above, and further in view of Hilt, U.S. Patent No. 6,032,133. McGurl does not disclose a "network based payment processing system of claim 1 wherein said predetermined rules include a rule denying authorization when a disbursement request has exceeded a limit." However, Hilt does disclose a bill pay system that reads an account balance to determine if sufficient funds are available to pay a bill and denies the transaction if the available balance is not sufficient (Col. 21 lines 5-12; Fig. 11 items 254, 256, 258). It would have been obvious to one skilled in the art to combine the two references because doing so prevents the issuance of checks

that will not be honored due to insufficiency of funds. Hilt provides the motivation to combine these references when it states that a check denied due to insufficient funds creates significant costs for the banks involved (Col. 5 lines 14-20).

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over McGurl as applied to claim 1 above, and further in view of Kahn et al, U.S. Patent No. 6,032,133. McGurl does not disclose a "network based payment processing system of claim 1 wherein said accounting process includes logic for tracking multiple awards to a particular recipient." However, Kahn does disclose a system that allows for the tracking of multiple awards to a particular recipient (Col. 11 lines 57-65, Col. 12 lines 1-10). It would have been obvious to one skilled in the art to combine these two references because to do so provides systems users with greater control over, and understanding of, payroll-related data. Kahn offers the motivation to combine these references when it offers that keeping track of employee data allows for easier compliance with federal, state and local tax and employment requirements (Col. 1 lines 26-30; Col. 5 lines 24-34).

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over McGurl as applied to claim 1 above, and further in view of Kahn. McGurl does not disclose a "network based payment processing system of claim 1 wherein said accounting process is further configured to track multiple funds corresponding to plurality of disbursement categories." However, Kahn does make this disclosure (Col. 5 lines 1-12, Col. 6 lines 1-23). It would have been obvious to one skilled in the art to combine these references because to do imparts greater capability on the McGurl system by allowing it to process

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not only regular payroll wage data but to also process tax and non-wage data. The motivation to combine the references is supplied by Kahn when it offers that the inclusion of this capability allows a company to more easily comply with tax rules, employment rules and company policies (Col. 5 lines 24-34).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ethan M. Dietrich, whose telephone number is 571-272-1874. The examiner can normally be reached on M-F 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on 571-272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

EMD


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PRIMARY EXAMINER
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